



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,175	07/26/2001	Yutaka Tatsuno	14809	7503

7590

08/06/2003

Paul J Esatto Jr
Scully Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

JOHNSON, HENRY I

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,175

Applicant(s)

TATSUNO ET AL.

Examiner

Henry M Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed May 19, 2003 have been fully considered but they are not persuasive as a result of newly uncovered art. Imaging capability used with endoscopes is widely used throughout the world. The mounting and manipulation of the elements to capture and display the image are disclosed in numerous patents. The sealing of endoscopes for sterilization is also well known. The claim rejections are based on the disclosure of all the features and the clear motivation to combine such features in an obvious manner.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,575,757 to Kennedy et al. Kennedy teaches endoscope with an imaging unit comprising optical elements (Fig. 1, # 22) for forming an image and a CCD to capture the image (Fig. 1, # 24) sealed within the device. The lens elements are fixed by epoxy (Col. 6, lines 46-48) and seals are provided to protect the focus mechanism during use and sterilization (Col. 5, lines 32-35). Focus is provided by moving the CCD in a longitudinal direction relative to the fixed lens (Col. 4, lines 44-46).

Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by JP11-216102 to Yamaguchi. Yamaguchi discloses an image pick-up apparatus for endoscopes with the optics and CCD hermetically sealed. The units hermetically sealed may be the CCD, focus lens and optical filter (paragraph 0110). Figure 7 discloses the CCD and optics in a hermetically sealed unit (sections 2 and 3 are both hermetically sealed and are connected with an O-ring seal to yield a sealed, integrated unit). The optical elements are fixed, with a mechanism for altering that fixed position, in a sealed section (Fig. 7, #2). The CCD is adjustable laterally using

Art Unit: 3739

set screws (driving means, Fig. 7, #206) to adjust the eccentricity of the camera head (paragraph 0121) relative to the optical elements.

Claim Rejections - 35 USC § 103

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP11-216102 to Yamaguchi as applied to claims 1 and 2 above, and further in view of U.S. Patent 5,575,757 to Kennedy et al. Both are discussed above. Additionally, Yamaguchi teaches mounting the image device in a frame that is connected to an endoscope (Fig. 3). Yamaguchi does not disclose moving the CCD in relation to the optical elements for focusing. Kennedy's focus mechanism moves the CCD in relation to the fixed optical elements. Imaging using optics and CCD's is pervasive in the art and it is well known that focusing may be achieved by moving either the CCD or the optics, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the CCD as taught by Kennedy in the invention of Yamaguchi to focus the image.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,575,757 to Kennedy et al as applied to claim 1 above, and further in view of U.S. Patent 5,797,836 to Lucey et al. Kennedy is discussed above, but does not disclose a rotation of the CCD. Lucey discloses an endoscope imaging device that includes rotation of the CCD within a sealed unit with respect to the optical member (Col. 1, lines 55-57). It is well know to rotate electronic images by either rotation of the image capture device or using electronic or software on the captured image, therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the rotation of the CCD as taught by Lucey in the invention of Kennedy to provide an image in the most user friendly orientation.

Conclusion

Art Unit: 3739

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

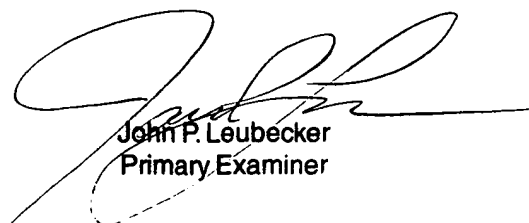
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Henry M Johnson, III
Patent Examiner
Art Unit 3739

Hmj
July 31, 2003


John P. Leubecker
Primary Examiner